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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/885,917

Applicant(s)

KENNY ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-14,22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14,22 of copending Application No. 09/885,915. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The wording of the claims is somewhat different; however, the scope of the claims is the same. If you infringe on the claims of the instant application you will necessarily be infringing the claims of 09,885,915 and vice versa. If one set of claims is infringed the other set will necessarily be infringed also. The difference in the claimed language that deals with the intended use of the article (i.e. "for conducting a rental transaction" as opposed to "for conducting a point-of-sale transaction) does not result in a different article structurally. A processing device with communication software can allow a rental transaction to occur just as well as a POS transaction. The type of transaction the processing device is conducting does not result in a different scope for the article claimed and does not structurally distinguish one set of claims over the other. The language concerning the data of the database and what it is for is also of the same scope in each set of claims. This is non-functional descriptive material and does define anything further to the article.

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3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 22 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 21 of copending Application No. 09/885,915. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 22 recites the invention substantially as is claimed in claim 21. The difference is that instant pending claim 22 fails to recite a browser limitation and a data entry field limitation as does claim 21 of 09/885,915. Claim 22 is broader with respect to this aspect of the rejection. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Claim 22 also recites a database connected to the server whereas claim 21 (of '915 app) does not recite a database. With respect to the failure to claim a browser and a data entry field, the deletion of an element is considered obvious. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). With respect to providing a database, in view of claim 21 of '915, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide claim 21 of '915 with a

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database to store all the information a business must deal with. The recitation of a database is considered obvious and its use is very old and well known in the art. One could almost argue a system of the type claimed cannot work with a database, that is how obvious it is (in the opinion of the examiner).

For claim 22, the only difference between claim 22 and the scope of claim 6 is the failure of claim 22 to recite "an office". Failure to claim an "office" is considered obvious as this is just a failure to recite a claimed limitation. This is a broadening out of the claimed invention recited in claim 6 of the '915 application. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1,2,4-14,22 are rejected under 35 U.S.C. 102(e) as being anticipated by Coutts et al. (6311165).

For claims 1,2,22, applicant should take notice that in article claims the name/type of the transaction (i.e. for rental transaction, and rental store management

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system) has been given minimal patentable weight. These are just descriptive words that describe the intended use of the system. With respect to the "digital form" language this is describing data (not a real tangible thing) that is considered to be non-functional descriptive material, so the type of data being transferred will also be given minimal patentable weight. Coutts discloses a transaction management system that includes a server (i.e. 334). The examiner considers the location of the server to be the claimed "office". The claimed "store" with processing device is considered to be the terminal (i.e. POS terminal 374) that inherently has a location. The terminal is disclosed as having a processor (i.e. 320) and communication software that allows the terminal of the store and server at the office to communicate and transfer data (a virtual private network). The processor and communication software are fully capable of conducting a rental transaction. Coutts is fully capable of sending the type of digital form claimed from the office to the store. As stated previously, the type of data is considered to be non-functional descriptive material and does not serve to distinguish over Coutts.

For claim 4, calling the previously recited office a store does not structurally add anything to the claim. The examiner considers the location of the server to be the office, which is considered to be a store. Applicant is merely reciting the name of the location of the server and this does not distinguish over Coutts.

For claims 5,6,8,9,22, Coutts discloses a database (i.e. 312).

For claim 7, Coutts discloses that the processor may receive data from the server in JAVA <sup>TM</sup> code and this requires the use of a browser as claimed. See for example column 3, lines 25-26.

For claims 10-12, the type of data recited is considered to be non-functional descriptive material and has been given minimal patentable weight. It has been given patentable weight to the extent that Coutts is fully capable of transmitting the type of data recited; therefore, Coutts is anticipatory.

For claim 13, Coutts discloses that the terminal with processor is provided with an IP address so to communication with the server. This is communication through the Internet as claimed.

For claim 14, in article claims the applicant is reciting a method limitation that deals with the data being transmitted. Claim 14 recites the encryption of data. The system of Coutts is fully capable of sending encrypted data that requires authentication as claimed. Applicants claim is directed to a method concerning the transmitted data (that itself is non-functional descriptive material) and has been given minimal patentable weight.

7. Claims 15-19 are rejected under 35 U.S.C. 102(a) as being anticipated by [www.Alamo.com](http://www.Alamo.com).

For claims 15,16,23,25,27, the Alamo document discloses an Internet web page where a consumer can go and reserve a vehicle for rent. When the consumer logs onto the Internet and goes to the Alamo web address, a digital form is sent from the office (the location of the Alamo server, database, etc.) to the rental store (the location of the computer being used by the consumer, which can be a rental agency itself). The digital form is displayed in the form of different data entry fields that ask for certain information.

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Under the section "Additional Equipment" the consumer may opt to have a ski rack installed on the rental car (merchandise/rental item that can be installed). The text "ski rack" and the box to check is a digital form that textually displays merchandise that may be installed on the vehicle. The consumer is also asked to identify the type of vehicle (customer vehicle form claim 23) in another digital form. With respect to the recitation of 1<sup>st</sup> and 2<sup>nd</sup> digital forms, Alamo discloses more than one digital form as claimed in the processing of the rental transaction. A rental quote is determined and displayed for the consumer to accept or decline. Alamo also discloses that a rental transaction is processed as claimed.

For claim 17,29, the use of a browser to view the digital forms is considered inherent. A browser is necessarily required (i.e. Internet Explorer, Netscape, etc.).

For claims 18,19,28, the use of a server and a database by Alamo is considered inherent.

For claim 26, at some point a search of a database has to be done to see if the ski rack can be used with the selected vehicle. Not all ski racks can be used on all vehicles. The limitation of claim 26 is considered to be inherently in Alamo.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of



the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coutts et al. (6311165).

For claim 3, Coutts discloses that the store has a router but does not disclose that the office has a router. Coutts discloses that the router at the store can act as a firewall to prevent unwanted communications with other devices. The use of a router is old and well known in the art and is considered obvious. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the office of Coutts with a router so that the server at the office had a router to act as a firewall to protect it in a similar manner to the office processor.

11. Claims 20,24, are rejected under 35 U.S.C. 103(a) as being unpatentable over www.Alamo.com. Alamo discloses the invention substantially as claimed. Alamo discloses the vehicle identification data is sent to the office but does not disclose that this data is in the form of an image. The data may be an identifying number, a name, or some other type of identifier for the vehicle type. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data be in the

form of an image because it does not matter what form the vehicle data takes, all that matters is that the desired vehicle is identified in some manner.

12. Claims 21,30, is rejected under 35 U.S.C. 103(a) as being unpatentable over www.Alamo.com in view of Johnson (5493490).

For claim 21, Alamo discloses that a picture of the selected car is displayed for the consumer during the rental process online. Alamo does not disclose the concept of displaying an image of the identified vehicle with the merchandise installed (such as with a ski rack). Johnson discloses a method of customizing proposals for vehicle sales where the photo of the vehicle is customized to the consumer's preferences. Johnson discloses that the consumer may choose from certain options that are available on the car (such as a type of wheels). Johnson further discloses that the photo displayed shows the desired options on the desired car. Johnson explains that this approach is very effective in making a sale because the proposal is tailored to the individual customer and their preferences, and this leads to better chance of making the sale. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have Alamo show the consumer a picture of the selected vehicle with any additional merchandise that has been selected (such as the ski rack) so that the rental proposal can be tailored to the customer to allow the best chance of obtaining a rental transaction. Alamo already shows the consumer a picture of the vehicle they want to rent, they disclose that additional equipment can be selected, so displaying a picture of the vehicle with the selected additional equipment is considered obvious in view of Johnson.

For claim 30, Alamo discloses the invention substantially as claimed. Alamo discloses the vehicle identification data is sent to the office but does not disclose that this data is in the form of an image. Alamo does not disclose the concept of displaying an image of the identified vehicle with the merchandise installed (such as with a ski rack).

With respect to the data being in the form of an image, the data of Alamo may be an identifying number, a name, or some other type of identifier for the vehicle type. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data be in the form of an image because it does not matter what form the vehicle data takes, all that matters is that the desired vehicle is identified in some manner. With respect to the recitation of "capturing an image of a customer's vehicle", because Alamo displays an image of the vehicles available for rent, the image of the customer's vehicle (the vehicle they desire to rent) inherently has been captured.

Concerning disclose the concept of displaying an image of the identified vehicle with the merchandise installed (such as with a ski rack). Alamo discloses that a picture of the selected car is displayed for the consumer during the rental process online. Alamo does not disclose the concept of displaying an image of the identified vehicle with the merchandise installed (such as with a ski rack). Johnson discloses a method of customizing proposals for vehicle sales where the photo of the vehicle is customized to the consumer's preferences. Johnson discloses that the consumer may choose from certain options that are available on the car (such as a type of wheels). Johnson further discloses that the photo displayed shows the desired options on the desired car.

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Johnson explains that this approach is very effective in making a sale because the proposal is tailored to the individual customer and their preferences, and this leads to better chance of making the sale. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have Alamo show the consumer a picture of the selected vehicle with any additional merchandise that has been selected (such as the ski rack) so that the rental proposal can be tailored to the customer to allow the best chance of obtaining a rental transaction. Alamo already shows the consumer a picture of the vehicle they want to rent, they disclose that additional equipment can be selected, so displaying a picture of the vehicle with the selected additional equipment is considered obvious in view of Johnson.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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DENNIS RUHL  
PRIMARY EXAMINER